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In the Supreme Court of the United States

OCTOBER TERM, 1961

No. 671

AUBREY A. LARSEN, PETITIONER

v.

DAVID L. LADD, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINION BELOW

The opinion of the United States Court of Customs and Patent Appeals (Pet. App. 1a) is reported at 292 F. 2d 531.

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on July 21, 1961 (Pet. App. 1a). A timely petition for rehearing was denied on October 24, 1961 (Pet. App. 1a). The petition for a writ of certiorari was filed on January 18, 1962. The petitioner attempts to invoke the jurisdiction of this Court under 28 U.S.C. 1256 (Pet. 2).

QUESTIONS PRESENTED

1. Whether this Court has jurisdiction to review a decision by the United States Court of Customs and Patent Appeals which affirmed the denial of certain patent claims by the Board of Appeals of the United States Patent Office.

2. Whether the United States Patent Office, whenever it allows as patentable certain claims to a chemical product, must also allow claims to the process by which that product was made, regardless of the patentability of the process standing alone.

STATUTE INVOLVED

The Act of July 19, 1952, c. 950, Section 103, 66 Stat. 798, 35 U.S.C. 103, provides in pertinent part:

> *Conditions for patentability; non-obvious subject matter*
>
> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

STATEMENT

Petitioner, in 1957, applied to the Patent Office for a patent on certain chemical compounds and on the processes by which the compounds were made (Pet.

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3, Pet. App. 1a). The Examiner allowed the product claims to the compounds but disallowed the process claims (Pet. 3, Pet. App. 1a). The process claims, involving "the production of esters of substituted benzoic acids by reacting an alkali metal salt of such an acid and an appropriate halohydrin or epoxide" (Pet. App. 1a), were held to be unpatentable over the prior art (Pet. App. 2a). The Examiner's decision was subsequently upheld by the Board of Appeals of the Patent Office, and petitioner then appealed to the United States Court of Customs and Patent Appeals (Pet. App. 1a).

The Court of Customs and Patent Appeals agreed with the Patent Office's conclusion that petitioner's invention was contained in the product claims, not the process or method claims, and "that if the compounds recited in appellant's allowed claims were disclosed in the prior art it would be obvious to a person of ordinary skill in the art to prepare them by the processes set forth" (Pet. App. 2a). The court further noted that petitioner had conceded that the process itself might not be patentable over the prior art, but contended that the process claims should have been allowed merely because the resulting products were found patentable (Pet. App. 2a).[1] Thus, the only issue presented was "whether a process for making a patentable compound is, ipso facto, a patent-

[1] Petitioner stated in his brief to the court below: "For purposes of this appeal, appellant concedes that, if the products made by his process were not novel and patentable, the process might not be patentable over the references cited" (Pet. App. 2a).

able process" (Pet. App. 2a). The court, concluding that "[w]hen the sole inventive concept resides in the product the claims should be limited to product claims" (Pet. App. 4a–5a), affirmed the decision of the Patent Office (Judge Smith dissenting).

ARGUMENT

It is, as petitioner must recognize, very doubtful whether decisions of the Court of Customs and Patent Appeals, in patent cases on appeal from the Patent Office, are now reviewable on certiorari by this Court, but there is no need for this Court to resolve that doubt in this case. Even if this Court has jurisdiction, there is no occasion for review because the decision below is plainly correct on the merits. It has long been established in patent law that process claims and claims for the resulting products are independent and must be viewed separately to determine patentability. The decision below correctly applies that settled principle to the facts of this litigation, and there is no conflict of decisions.

1. In *Postum Cereal Co.* v. *Calif. Fig Nut Co.*, 272 U.S. 693, this Court held that it lacked jurisdiction to review decisions of the Court of Appeals of the District of Columbia in appeals from determinations of the Patent Office in patent and trademark applications. It was said that the decision in an appeal from the Patent Office was not a judicial judgment but was "merely an instruction * * * by a court which is made part of the machinery of the Patent Office for administrative purposes." 272 U.S. 698–699. The jurisdiction of the Court of Appeals of

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the District of Columbia over patent and trademark matters was subsequently transferred to the Court of Customs and Patent Appeals. Act of March 2, 1929, c. 488, Sections 1–4, 45 Stat. 1475. But the basic nature of the proceeding was not changed, and thereafter, in denying certiorari in *Pacific Northwest Canning Co.* v. *Skookum Packers' Assn.*, 283 U.S. 858 (trademark case), and in *McBride* v. *Teeple*, 311 U.S. 649 (patent case), the Court specifically noted that the denial was "for want of jurisdiction," citing *Postum Cereal.* In subsequent patent cases, the Court has merely denied certiorari, without more.

Petitioner relies upon two relatively recent statutory changes as indicating that patent decisions of the Court of Customs and Patent Appeals are now reviewable by this Court. The first statutory change was made by 28 U.S.C. 1256—part of the Act of June 25, 1948, 62 Stat. 683, codifying Title 28 of the United States Code—which provided generally, for the first time, that cases in the Court of Customs and Patent Appeals are reviewable by this Court. The other statutory change is the 1958 amendment to 28 U.S.C. 211, designating the Court of Customs and Patent Appeals as a court established under Article III of the Constitution.

We believe that, despite some of the language in the *Postum Cereal* opinion, there are no constitutional obstacles to review by this Court of the patent rulings of the court below (see the Brief for the United States in *Lurk* v. *United States*, No. 481, this Term, pp. 104 *et seq.*), but at the same time there is the gravest doubt whether the Congress has as yet

vested this Court with that jurisdiction. See the government's brief in opposition to certiorari in *Commissariat à L'Energie Atomique* v. *Watson,* No. 826, Oct. Term, 1959, pp. 6–9, certiorari denied, 362 U.S. 977.

2. However, even if the Court were to decide that it now has jurisdiction to review patent decisions of the Court of Customs and Patent Appeals, there would be no occasion to exercise that jurisdiction in this case. The contention advanced by petitioner—that whenever a product is patentable the method by which it is made is also patentable regardless of the novelty of the method—is refuted by many decisions of this Court and the lower federal courts. A process or method by which a particular product is made, whether the process be mechanical or chemical, may be the subject of allowable patent claims; but, in order for such claims to be patentable, the process itself must meet the standards of patentability. This was emphasized by the Court in *Paramount Corp.* v. *Tri-Ergon Corp.,* 294 U.S. 464, 473:

> To claim the merit of invention the patented process must itself possess novelty. The application of an old process to a new and closely analogous subject matter, plainly indicated by the prior art as an appropriate subject of the process, is not invention. * * *

See, also, *Cochrane* v. *Deener,* 94 U.S. 780, 787–788; *Expanded Metal Co.* v. *Bradford,* 214 U.S. 366, 381–386; *Bauer Bros. Co.* v. *Bogalusa Paper Co.,* 96 F. 2d 991, 994 (C.A. 5).

In the present case, both the Patent Office and the Court of Customs and Patent Appeals found as a fact

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that petitioner's process claims did not possess novelty. This the petitioner does not dispute, but merely relies on the novelty of the product. However, as the Court of Appeals for the Sixth Circuit has said: "The fact that a new subject is reproduced does not establish the validity of a process patent unless the method of reproduction is new. *Paramount Publix Corp.* v. *American Tri-Ergon Corp.*, 294 U.S. 464, 473 * * *." *Oxford Varnish Corporation* v. *General Motors Corp.*, 120 F. 2d 44, 47 (C.A. 6). Since petitioner's process claims standing alone lack invention, they could not be the subject of allowable patent claims.

The correctness of the decision below is further underscored by *Rubber Company* v. *Goodyear*, 9 Wall. 788, 796. There this Court, in language directly apposite to petitioner's contention, stated:

> A machine may be new, and the product or manufacture proceeding from it may be old. In that case the former would be patentable and the latter not. The machine may be substantially old and the product new. In that event the latter, and not the former, would be patentable. Both may be new, or both may be old. In the former case, both would be patentable; in the latter neither. *The same remarks apply to processes and their results. Patentability may exist as to either, neither, or both, according to the fact of novelty, or the opposite. The patentability, or the issuing of a patent as to one, in nowise affects the rights of the inventor or discoverer in respect to the other. They are wholly disconnected and independent facts.* Such is

> the sound and necessary construction of the statute. [Emphasis added.]

While in some situations claims that can be designated "process claims" may be viewed as integral parts of the products, generally "method" or "process" claims are, as the *Rubber Company* case points out, independent and must stand or fall on their own, irrespective of the patentability of the products.[2] In *Holland Furniture Co.* v. *Perkins Glue Co.*, 277 U.S. 245, 254–258, the Court pointed out that the term "process" is sometimes used, inaccurately, to describe "an essential ingredient of a composition of matter," and in such a case the "process" is "inseparable from the composition itself." 277 U.S. at 255–256. However, where the term is employed to describe the method by which a product is made, the Court reaffirmed the applicability of the rule that the process and product claims are distinct and inde-

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[2] To the same effect as the *Rubber Company* case, that process claims and product claims are separate and independent with respect to patentability, see, *In re Cady*, 77 F. 2d 106, 109 (C.C.P.A.); *Buono* v. *Yankee Maid Dress Corporation*, 77 F. 2d 274, 279 (C.A. 2); *Binney & Smith Co.* v. *United Carbon Co.*, 125 F. 2d 255, 258 (C.A. 4); *General Electric Co.* v. *De Forest Radio Co.*, 17 F. 2d 90, 96 (D. Del.), modified, 28 F. 2d 641 (C.A. 3), certiorari denied, 278 U.S. 656; *Malina* v. *Grisman*, 20 F. 2d 406 (E.D. N.Y.), affirmed *per curiam*, 20 F. 2d 409 (C.A. 2); *Steinfur Patents Corporation* v. *J. Meyerson, Inc.*, 56 F. 2d 372 (E.D. N.Y.); *cf.*, *Application of Touvay*, 264 F. 2d 901, 903 (C.C.P.A.), where the court stated: "It is well settled that the allowability of one set of claims cannot be predicated on the patentability of other claims in the same application. * * *"

pendent, and that "[e]ither or both may be patentable." 277 U.S. at 255.[3]

There is absolutely no merit to petitioner's argument that 35 U.S.C. 103, *supra*, p. 2, changes the prior law and enlarges the area of patentable claims to include process claims where the process itself lacks invention. To the contrary, it is clear from the terms of Section 103 that its purpose was to codify a rule designed to limit the type of claim on which a patent may be granted. It provides that, even if there are differences between the subject matter of the claims and the prior art, a patent shall not issue if the "subject matter as a whole would have been obvious" to a person skilled in the art. Certainly, this does not support the contention that process claims, lacking novelty, are patentable merely because the resulting product is patentable.

Moreover, the legislative history of 35 U.S.C. 103 refutes the petitioner's assertion that the section was designed to change prior law and cause allowance of claims that had previously been disallowed. The report of the House of Representatives Committee on the Judiciary, accompanying H.R. 7794, 82d Cong., 2d Sess., which was the bill to revise and codify

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[3] For other cases describing this distinction, see, *e.g.*, *Cochrane* v. *Badische Anilin & Soda Fabrik*, 111 U.S. 293, 310; *Anraku* v. *General Electric Co.*, 80 F. 2d 958, 964 (C.A. 9). The term "process" is also sometimes used in patent cases in a third sense, not here relevant, to describe the "function" or "use" of a particular product. See, *e.g.*, *James* v. *Campbell*, 104 U.S. 356; *Risdon Locomotive Works* v. *Medart*, 158 U.S. 68; *Westinghouse* v. *Boyden Power Brake Co.*, 170 U.S. 537.

Title 35 of the United States Code, stated (H. Rept. No. 1923, 82d Cong., 2d Sess., p. 7):

> Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the courts. An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent. That has been expressed in a large variety of ways in decisions of the courts and in writings. Section 103 states this requirement in the title. It refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in section 102. If this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then the subject matter cannot be patented.
>
> That provision paraphrases language which has often been used in decisions of the courts, and the section is added to the statute for uniformity and definiteness. This section should have a stabilizing effect and minimize great departures which have appeared in some cases.

To the same effect, see p. 18 of H. Rept. No. 1923, *supra*, and S. Rept. 1979, 82d Cong., 2d Sess., p. 6. It is clear from both the language of the section and its legislative history that no change in the prior law was contemplated. And, as we have pointed out, it

is also clear from that prior law that a process claim lacking invention in itself does not become patentable merely because a patentable product may result.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

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